

REMARKS

To begin with, we hope to convey the frustration we feel regarding the PTO's inconsistent and inefficient examination of this case. This case has been with the PTO now for almost five years. In that time, no fewer than four Examiners have been successively assigned to the case. Each new assignment resulted in prosecution inefficiencies and otherwise delayed allowance of the case, as each newly assigned Examiner required time to become familiar with the case and perfected his/her understanding of the invention as he/she advanced prosecution. Examiner Tran was introduced to the case over five months ago. We trust that, in that time, the inventive features of the present case have become familiar to her. They remain new to the art, however, as demonstrated by the inability of this Examiner (and every Examiner before her) to find a single reference that *teaches or suggests* the claimed high-throughout screening method.

That being said, each of the rejections levied in the Advisory Action is discussed individually in detail below.

The proposed amendments filed November 5, 2003 were not entered because the Examiner alleges that they (i) raise new issues that would require further consideration and/or search; (ii) raise the issue of new matter; and (iii) are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

Firstly, Applicant is baffled by the Examiner's assertion that the 11/5/03 amendments introduce new matter and/or new issues that would warrant further consideration and/or a new search, as *all* the proposed amendments find support in previously presented claims.

The Examiner points to the addition of the language "antibody-component" in claim 57 and "wherein the antibody interacts with the post-translationally modified protein" in claim 81, and alleges that it was not previously presented. Applicant had provided specific support for this language in the 11/5/03 Response (See, for example, section entitled "Amendments to Claims" on page 9). It was explicitly stated that the antibody language in claims 57-59, 64, 65 and 81 finds support, for example, in (now canceled) claims 61 and 62, which recited that the ligand could be an antibody. Accordingly, the amendment replacing the term "ligand" with "antibody" in claims 57-59, 64, 65 and 81 cannot introduce new matter. In addition, as mentioned above, the notion that the ligand may be an antibody was in fact previously presented (*e.g.*, as claims 61 and 62). Therefore, the subject matter has been (or should have been) considered and examined, and does not warrant further consideration and/or search.

With respect to claim 81, the change from "intracellular component" to "protein" merely incorporates the limitation of claim 79 from which claim 81 depends. Claim 79 recites that the intracellular component may be a protein. Therefore, claim 81, as presented in the 11/5/03 Response, cannot present new matter nor does it require further consideration and/or search.

The Examiner also alleges that the replacement of the language "seconds are thirds" with "the second antibody is a third antibody" in claim 58 raises new issues that would require further consideration and search. Applicant strongly disagrees and submits that the Examiner's statement is simply incorrect. Applicant merely adopted language that the Examiner had suggested, namely, replace the language "wherein seconds are thirds" with "wherein the second ligand is a third ligand" (See paper 30 mailed September 5, 2003, page 4, section 12, last sentence). In addition, Applicant incorporated the limitation of (now canceled) claim 62 that the ligand is an antibody, thereby introducing the language "wherein the second antibody is a third antibody". Clearly, the subject matter was previously presented and *has* in fact been considered and examined.

Secondly, Applicant objects to the Examiner's statement that the proposed 11/5/03 amendment is not deemed to place the application in better form for appeal because "the art rejections of record would still read on the claims". Applicant assumes that the Examiner meant "the instant claims would still read on the art of record" or "the art of record would still correspond to the instant claims", whereby the "art of record" refers to the references cited in the § 102 rejections levied in the 9/5/03 final rejection. Applicant consistently maintained and argued throughout prosecution that the claimed invention was novel over the art of record. However, in view of the Examiner's refusal to allow the claims, and solely in an effort to expedite allowance of this case, Applicant has amended the claims to introduce the limitation of (now canceled) claims 61 and 62 that the ligand is an antibody. The instant claims, as amended in the 11/5/03 Response, clearly and unambiguously overcome the § 102 art rejections of record, as extensively discussed on pages 10-12 of the 11/5/03 Response.

Accordingly, the Examiner's assertion that the 11/5/03 Response is not deemed to place the application in better form for appeal on the grounds that the instant claims still reads on the art of record is simply unfounded. For the convenience of the Examiner, Applicant has summarized below why the § 102 art rejections of record are improper. The Examiner is

respectfully invited to consult pages 10-12 of the 11/5/03 Response for a more comprehensive discussion of Applicant's position.

Rejection under 35 U.S.C. § 102(b)

Applicant reiterates and maintains that the Photiou *et al.* reference *did not* anticipate the claims prior to the 11/5/03 amendment (*i.e.*, claims reciting a "ligand"), and *does not* anticipate the instant claims (*i.e.*, claims reciting an "antibody"). Specifically, no description can be found anywhere in the Photiou *et al.* reference of a high-throughput assay comprising steps of introducing into each of a plurality of reaction vessels (i) a plurality of cells, (ii) one or more test compounds whose effect on an intracellular biological or chemical process is to be evaluated, and (iii) *an antibody that associates intracellularly with a biological component whose presence or amount reveals the effect of a given test compound on the biological or chemical process*; and (iv) *assaying for antibody-component association in the reaction vessels*; wherein the plurality of reaction vessels comprises at least 96 reaction vessels. The Examiner, and the Examiner previously assigned to the case, have failed to find *any* explicit description of the presently claimed invention in the Photiou *et al.* reference (*i.e.*, including *all* the claim limitations). Therefore, the cited reference cannot be held to anticipate the instant claims. The rejection under 35 U.S.C. § 102(b) over the Photiou *et al.* reference is improper, and should have be withdrawn in the Advisory Action.

Rejection under 35 U.S.C. § 102(e)

Taylor's screening method differs from Applicant's claimed invention at least in that it uses luminescent reporter molecules as means of detection, not *an antibody* which, after introduction in the reaction vessels (*e.g.*, wells), *associates intracellularly with a biological component whose presence or amount reveals the effect of a given test compound on the biological or chemical process*. Therefore, the Taylor reference cannot anticipate the claimed invention. Accordingly, the rejection under 35 U.S.C. § 102(e) over the Taylor reference is improper and should have be withdrawn in the Advisory Action.

In view of the above Remarks, the Examiner's assertion that the 11/5/03 Response is not deemed to place the application in better form for appeal is clearly unfounded.

Although not explicitly referred to in the Advisory Action, Applicant addresses below the § 103 rejection levied in the final rejection mailed 9/5/03 in an effort to make perfectly clear that

the stated rejection is *de facto* improper. The Examiner is respectfully directed to the discussion detailed on pages 12-15 of the 11/5/03 Response. [Applicant points out that the arguments set forth in the 11/5/03 Response refer to the amended claims (*i.e.*, claims including the "antibody" limitation). However, the arguments are equally valid for the claims presented prior to the amendment (*i.e.*, claims reciting a "ligand"), as detailed on pages 13-15 of Applicant's Response filed May 19, 2003. The arguments presented in the 11/5/03 Response or the present paper do not infer, nor should they be construed to mean, that the introduction of the "antibody" limitation changed anything to the impropriety of the § 103 rejection levied in the 9/5/03 final rejection.]

Rejection under 35 U.S.C. § 103

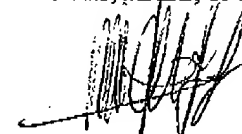
With respect to the rejection under 35 U.S.C. § 103(a) over one or more of Walsh, Photiou *et al.*, Juan *et al.*, Claycomb and the Final Conference Program of LabAutomation '98 in San Diego, CA January 17-21, 1998, pages 99, 100, 124, 129 and 212, Applicant has clearly demonstrated that the cited combination of references does not meet the legal standard for establishing a *prima facie* case of obviousness. Specifically, there is no teaching or suggestion in any of the cited references to modify or combine the teachings of any one or more of the Walsh, Photiou *et al.*, Juan *et al.*, and/or Claycomb references and the teachings of the Final Conference Program of LabAutomation '98 reference to achieve the claimed invention. In addition, Applicant has established that there is no reasonable expectation of success in the combination. Accordingly, the rejection under 35 U.S.C. § 103(a) levied in the 9/5/03 final rejection is improper.

CONCLUSION

Based on the Remarks presented above and in the 11/5/03 Response, it is submitted that the claims, as amended in the 11/5/03 Response, are allowable over the art of record. The claims are fully supported by the specification and the amendments presented in Applicant's 11/5/03 Response do not raise new issues that would warrant further consideration and/or a new search. Accordingly, the amendments filed November 5, 2003 should be entered and the patent should issue. A Notice to that effect is respectfully requested. It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required for consideration of this paper (including fees for net addition of claims) are authorized to be charged to our Deposit Account No. 03-1721.

In view of the imminent statutory deadline for reply (March 5, 2004), and in order to prevent any further unnecessary delay in the prosecution of this case, the Examiner is invited to fax the undersigned a copy of any communication that will be mailed in response to this paper at (617) 248-4000.

Respectfully submitted,  
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